

REMARKS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

The title of the invention has been objected to as not being descriptive. Accordingly, the title has been rewritten which is indicative of the invention as claimed and it is requested that new title be accepted.

The abstract of the disclosure has been objected. Accordingly, the abstract of the disclosure has been rewritten to satisfy the Examiner's objection. It is requested that new abstract be accepted.

The drawings have been objected to because of informalities. New formal drawings are submitted herewith.

The information disclosure statement filed September 13, 2000 has been objected to for allegedly failing to comply with 37 CFR 1.98(a)(2). Applicant kindly directs the Examiner attention to 37 CFR 1.98(d) which indicates that copies of the references are not required when earlier application is properly identified in the information disclosure statement. Applicant respectfully submits that the information disclosure statement has been properly submitted under 37 CFR 1.98(d).

Claims 417, 418, 420, and 421 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,009,459 (Belfiore et al.). Applicant respectfully traverse this rejection.

Belfiore et al. relates to "a method for automatically initiating a search for a resource such as web site when a user has specified (entered) text that is not a valid identifier for the resource, e.g., a uniform resource locator (URL)" (col. 2, lines 13-16) "When the system determines that the text entered in the Address box is not a proper URL, the system processes the text and puts the resulting text into a template in the registry" (col. 3, line 67 to col. 4, line 3). "Before initiating the Autosearch, an attempt is made to construct a valid URL from the processed text (step 91 in FIG.7). This entails prepending a scheme prefix to the beginning of the processed text. For example, if the processed text begins with "www," the prefix "http://" is prepended to the beginning of the text. Similarly, the prefixes "ftp://" and "gopher://" (col. 6, lines 15-21).

However, contrary to the Examiner's assertion, Belfiore does not teach or suggest "contextually determining a domain associated with said host server to provide a complete

uniform resource locator,” as required in amended claims 417 (and similarly in claim 420). The present system contextually determines the complete URL even when the subscriber simply enters a host name, such as “ibm” (see page 24, line 1 to page 25, line 7 of the specification). Accordingly, it is appreciated that the one of ordinary skill in the art would not associate the step of prepending the prefix http:// in Belfiore to be equivalent to the claimed step of “contextually determining a domain associated with said host server to provide a complete uniform resource locator,” as required in amended claim 417 (and similarly in claim 420).

Of course, a rejection based on 35 U.S.C. §102 as the present case, requires that the cited reference disclose each and every element covered by the claim. Electro Medical Systems S.A. v. Cooper Life Sciences Inc., 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988); Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2D 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. 102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." Connell v. Sears, Roebuck & Co., 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 814 F.2d at 631.

In view of the foregoing differences and authorities, it is respectfully submitted that Belfiore et al. does not anticipate the present invention as now recited in amended independent claims 417 and 420, and therefore, claims 417 and 420 are patentably distinct over Belfiore et al. It is requested that the rejection of claims 417 and 420 under 35 U.S.C. § 102((e) be withdrawn.

In addition, it is undeniable that Belfiore et al. is not even remotely concern with the problem of providing a complete URL based on a host name. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by Belfiore et al., the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner’s rejection. “The problem solved by the invention is always relevant”. Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem of providing a complete URL based on a host name was even recognized by the prior art, there can be no finding that the invention as a whole

would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), “an inventive contribution can reside as well in the recognition of a problem as in a solution”. It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that “[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection”. Id. at 121.

In view of the foregoing authorities, it is submitted that, since Belfiore et al. is not even aware of the problem addressed by applicant, and since the cited prior art reference does not suggest the solution defined by claims 417 and 420, these claims are unobvious and patentably distinct over Belfiore et al. It is requested that the rejection of claims 417 and 420 under 35 U.S.C. § 102(e) be withdrawn.

Since claims 418 and 421 depend from claims 417 and 420, respectively, the foregoing discussion of claims 417 and 420 is equally applicable to claims 418 and 420 and is believed to obviate the rejection of claims 418 and 421.

In addition, claim 418 (and similarly claim 420) required that the domain be determined “as a function of a probability distribution of the number of host servers in a particular domain.” Belfiore et al. does not teach or suggest determining the domain in such manner. In fact, col. 7, lines 5-20, in Belfiore et al, cited by the Examiner merely describes that “the search engine initiates a search using the terms that were passed in the template to produce search results.”

Claims 419 and 422 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belfiore et al. in view of U.S. Patent No. 6,163,779 (Mantha et al.).

Mantha et al. is directed to a method of saving a web page to a local hard drive to enable client-side browsing. But, Mantha et al. is not suggestive of “contextually determining a domain associated with said host server to provide a complete uniform resource locator.” These, of course, is feature recited by independent claims 417 and 420 (and thus included in dependent claims 419 and 422) and not found in Belfiore et al. and Mantha et al. Hence, the addition of Mantha et al. does not cure aforementioned deficiency of Belfiore et al.

In view of the foregoing differences, it is respectfully submitted that the combination of Belfiore et al. and Mantha et al. does not render obvious claims 419 and 422. It is respectfully requested that rejection of claims 419 and 422 under 35 U.S.C. § 103 be withdrawn.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the applicant’s undersigned attorney and, in the event that the Examiner

disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Applicant's representative agrees with the Examiner's implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Belfiore et al. and Mantha et al.

Accordingly, it is respectfully maintained that all rejections and objections have been overcome, and that the present application is now in condition for formal allowance.

Applicant believes no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **VSD 201.1 CONT (10008454)** from which the undersigned is authorized to draw.

Respectfully submitted,

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